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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/931,749

Applicant(s)

ROYALL ET AL.

Examiner

Jonathan Ouellette

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) 20,21 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18, 19 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Claim 17 has been cancelled, and Claims 20, 21, and 23 have been withdrawn from consideration; therefore, Claims 1-16 and 18-23 are pending in application 09/931,749.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 16, 18, 19, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanoff et al. (Sanoff, Alvin P.; Glastris, Kukula, The Consulting game: Schools turn to outside help to target and select students." US News & World Report, v119, n11, p119 (4), September 18, 1995) in view of Schillewaert et al (Schillewaert, Niels; Langerak, Fred; Duhamel, Tim, "Non-probability sampling for WWW surveys: a comparison of methods." Journal of the Market Research Society, October 1998.).
4. As per **independent Claim 1**, Sanoff discloses a method for surveying candidates (pg.2, telequalifying) who may be interested in an educational institution comprising the steps of:
 - (a) obtaining a list of candidates who are believed to have an interest in attending an educational institution;
 - (b) developing a data base relating to the candidates;
 - (c) using the

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information in the data base to segment the candidates into one or more candidate segments based on one or more criteria established by the educational institution (Pg.2, developing applicant pool); (e) preparing a mailing package for each candidate; (f) distributing the mailing package to each candidate (Pg.2, Direct Mailing, Target Marketing); and (g) evaluating the interest of each candidate completing a survey (Pg.2, determining extent of applicant interest).

5. Sanoff fails to expressly disclose (d) establishing an Internet based web page containing a survey form and (e) preparing a mailing package for each candidate, which includes an incentive to respond and a unique user name and password for accessing the survey form by the Internet.
6. However, Schillewaert discloses a method for surveying customers (potential applicants), which includes establishing a web-based survey, and inviting the customer to take the survey through several conventional means (pg.1, recruiting respondents), and it would have been obvious for Schillewaert to include user password and ID information along with the survey invitation, as a common way for properly securing the survey web-based system and tracking the survey results.
7. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included (d) establishing an Internet based web page containing a survey form and (e) preparing a mailing package for each candidate which includes an incentive to respond and a unique user name and password for accessing the survey form by the Internet, as disclosed by Schillewaert in the system disclosed by Sanoff, for the advantage of providing a method for surveying candidates who may be interested in an educational

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institution, with ability to increase system effectiveness and efficiency by incorporating Internet technology in the surveying process, thereby increasing the automated reach of the system to customers, while decreasing transmission costs (Automation of a manual process: *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)).

8. As per **independent Claim 16**, Sanoff discloses a method for surveying candidates who may be interested in an educational institution comprising the steps of: (a) obtaining a list of candidates who are believed to have an interest in attending an educational institution; (b) developing a data base relating to the candidates; (c) using the information in the data base to segment the candidates based on one or more criteria established by the educational institution; (f) distributing the mailing package to each candidate; and (h) evaluating the interest of each candidate completing a survey.
9. Sanoff fails to expressly disclose (d) establishing an Internet based web page containing a survey form; (e) preparing a mailing package for each candidate which includes (1) an incentive to respond, (2) a unique user name and password for accessing the survey form by the Internet, and (3) a postage prepaid response card; and (g) e-mailing each candidate from a named individual at an e-mail address which includes the name of the institution a unique user name and password for electronically accessing the survey form and a hyperlink to the survey form.
10. However, Schillewaert discloses a method for surveying customers (potential applicants), which includes establishing a web-based survey, and inviting the customer to take the survey through e-mailing (pg.1, recruiting respondents), and it would have been obvious for Schillewaert to include user password and ID information along with the survey invitation, as

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a common way for properly securing the survey web-based system and tracking the survey results.

11. Furthermore, Schillewaert discloses offering incentives to participants of the survey system (pg.5).
12. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included (d) establishing an Internet based web page containing a survey form; (e) preparing a mailing package for each candidate which includes (1) an incentive to respond, (2) a unique user name and password for accessing the survey form by the Internet, and (3) a postage prepaid response card; and (g) e-mailing each candidate from a named individual at an e-mail address which includes the name of the institution a unique user name and password for electronically accessing the survey form and a hyperlink to the survey form, as disclosed by Schillewaert in the system disclosed by Sanoff, for the advantage of providing a method for surveying candidates who may be interested in an educational institution, with ability to increase system effectiveness and efficiency by incorporating Internet technology in the surveying process, thereby increasing the automated reach of the system to customers, while decreasing transmission costs (see also automation of a manual process: *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)).
13. As per **independent Claim 18**, Sanoff discloses a method for determining the interest of candidates in attending an educational institution (pg.2, telequalifying).
14. Sanoff fails to expressly disclose the steps of electronically contacting the candidate to provide a hyperlink to an electronic survey customized with information previously obtained about the candidate (User Name).

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15. However, Schillewaert discloses a method for surveying customers (potential applicants), which includes establishing a web-based survey, and inviting the customer to take the survey through several conventional means (pg.1, recruiting respondents), and it would have been obvious for Schillewaert to include user password and ID information along with the survey invitation, as a common way for properly securing the survey web-based system and tracking the survey results.
16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included (d) establishing an Internet based web page containing a survey form and (e) preparing a mailing package for each candidate which includes an incentive to respond and a unique user name and password for accessing the survey form by the Internet, as disclosed by Schillewaert in the system disclosed by Sanoff, for the advantage of providing a method for surveying candidates who may be interested in an educational institution, with ability to increase system effectiveness and efficiency by incorporating Internet technology in the surveying process, thereby increasing the automated reach of the system to customers, while decreasing transmission costs (Automation of a manual process: *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)).
17. As per Claim 19, Sanoff and Schillewaert disclose wherein the candidate is also provided with a unique identification and including the further step of disabling the unique identification upon the completion of a survey (one-time use programming).
18. As per **independent Claim 22**, Sanoff discloses a method for determining the interest of candidates in attending an educational institution (pg.2, telequalifying).

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19. Sanoff fails to expressly disclose using a predetermined metric to electronically convert a free form response to an electronic survey to an indication of interest.
20. However, Schillewaert discloses a method for surveying customers (potential applicants), which includes establishing a web-based survey, and inviting the customer to take the survey through several conventional means (pg.1, recruiting respondents); and furthermore, a free form input was a well known form of data entry for surveys to one of ordinary skill in the art when the invention was made, and would be a common automated step in survey data analysis.
21. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included using a predetermined metric to electronically convert a free form response to an electronic survey to an indication of interest, as disclosed by Schillewaert in the system disclosed by Sanoff, for the advantage of providing a method for determining the interest of candidates in attending an educational institution, with ability to increase system effectiveness and efficiency by automatically analyzing the survey responses.
22. **Claims 2-6 and 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanoff et al. (Sanoff, Alvin P.; Glastris, Kukula, The Consulting game: Schools turn to outside help to target and select students." US News & World Report, v119, n11, p119(4), September 18, 1995) in view of Thomas (US 2002/0002482 A1)**
23. As per **independent Claim 2**, Sanoff discloses a method for surveying those candidates (pg.2, telequalifying) who may be interested in an educational institution comprising the steps of: (a) obtaining a list of candidates who are believed to have an interest in attending an

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educational institution; (b) developing a database relating to the candidates; (c) using the information in the data base to segment the candidates based on one or more criteria established by the educational institution (Pg.2, developing applicant pool); and (f) evaluating the interest of each candidate completing a survey (Pg.2, determining extent of applicant interest).

24. Sanoff fails to expressly disclose electronically surveying candidates by (d) establishing an Internet based web page containing a survey form; (e) e-mailing each candidate from a named individual at an e-mail address which includes the name of the institution a unique user name and password for electronically accessing the survey form and a hyperlink to the survey form.

25. However, Thomas discloses a method for surveying customers (potential applicants), which includes establishing a web-based survey, and inviting the customer to take the survey through e-mailing (Para 0048), and providing user password and ID information along with the survey invitation (Para 0065).

26. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included electronically surveying candidates by (d) establishing an Internet based web page containing a survey form; (e) e-mailing each candidate from a named individual at an e-mail address which includes the name of the institution a unique user name and password for electronically accessing the survey form and a hyperlink to the survey form, as disclosed by Thomas in the system disclosed by Sanoff, for the advantage of providing a method for surveying candidates who may be interested in an educational institution, with ability to increase system effectiveness and efficiency by incorporating

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Internet technology in the surveying process, thereby increasing the automated reach of the system to customers, while decreasing transmission costs (see also automation of a manual process: *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)).

27. As per Claim 3, Sanoff and Thomas disclose wherein the hyperlink is specially coded for those candidates who use AMERICA ONLINE (Thomas: equivalent technology for any service provider – the type of service provider would be non-functional).
28. As per Claim 4, Sanoff and Thomas disclose wherein the survey form is customized using information from the data base (Sanoff: Targeted Applicant Marketing).
29. As per Claim 5, Sanoff and Thomas disclose wherein the survey form is customized with graphics as a function preselected candidate information in the data base (Sanoff: Targeted Applicant Marketing).
30. As per Claim 6, Sanoff and Thomas fail to expressly disclose wherein the information is related to an extracurricular activity.
31. However, Sanoff discloses providing target marketing to Applicant, based on Applicant information (Pg.2) – the type of information would be non-function to the claimed method steps. *See In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
32. As per Claim 8, Sanoff and Thomas disclose wherein the database is automatically updated by the information provided in the survey.
33. As per Claim 9, Sanoff and Thomas disclose wherein the unique identifier is locked out upon completion of the survey to thereby prevent multiple surveys from the same candidate (one-time use programming).

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34. As per Claim 10, Sanoff and Thomas disclose wherein the web site is only accessible by a user with a unique identifier (Thomas Para 0065).
35. As per Claim 11, Sanoff and Thomas fail to expressly disclose the further step of following up with a second e-mail a predetermined time after the initial e-mail in the absence of a response.
36. However, it would have been obvious to one of ordinary skill in the art to repeat survey method steps provided by Sanoff in view of Schillewaert, if no response was received from an Applicant designated from the Applicant pool to receive the initial communication, as a way to improve the chances of recruiting applicants.
37. As per Claim 12, Sanoff and *Thomas* disclose including the real time monitoring of the web site.
38. As per Claim 13, Sanoff and *Thomas* disclose the step of updating a separate reporting web site indicative of cumulative activity of all candidates.
39. As per Claim 14, Sanoff and *Thomas* disclose wherein the reporting web site includes the number of candidates responding to each question on the survey.
40. As per Claim 15, Sanoff and *Thomas* disclose the steps of: (h) compiling the results of the evaluation of all candidates completing the survey; and (i) forwarding the compiled results to the educational institution.
41. **Claim 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanoff et al. in view of Thomas, and further in view of De Rafael et al.**

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42. As per Claim 7, Sanoff and Schillewaert fail to expressly disclose wherein the survey form is interactive in that modifications to the survey are made in response to responses entered by the candidate.
43. However, De Rafael discloses an electronic survey system, which dynamically generates further questions in response to the users' answers to previous questions (abstract).
44. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the surveying system comprises the steps of: electronically surveying the candidate with a survey in which subsequent questions are dynamically varied as a function of the responses to previous questions, as disclosed by De Rafael in the system disclosed by Thomas, in the system disclosed by Sanoff, for the advantage of providing a method for determining the interest of candidates in attending an educational institution, with ability to increase system effectiveness and efficiency by retrieving the most detailed information as possible from the survey users.

Response to Arguments

45. Applicant's arguments filed 9/25/2006, with respect to Claims 1-16, 18, 19, and 22, have been considered but are not persuasive. The rejection will remain as FINAL, based on the cited prior art.
46. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will

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expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

47. As per Claims 1, 16, 18, 19, and 22, the Applicant has made the argument that the cited prior art fails to expressly teach or disclose a unique user name and password for accessing the survey form.

48. However, Schillewaert does disclose inviting potential users via e-mail to participate in the online survey (pg.4 of 10). The users are individually identified by their e-mail address, and as secure Internet logins were well known at the time the invention was made (See THOMAS US 2002/0002482 A1, Para 0065, as a teaching reference), it would have been obvious to provide the user with a password to be correlated with their e-mail address for secure system monitoring and user identification.

49. Furthermore, the Applicant has made the argument that the cited prior art fails to expressly teach or disclose including an incentive to respond to the survey.

50. However, Schillewaert does disclose providing an incentive (entered into a contest) for users to *completely respond* to the survey by including identity information in the full response (pg.5 of 10).

51. As per Claims 16 and 18, the Applicant has made the argument that the cited prior art fails to expressly teach or disclose a postage prepaid response card, an email that includes the name of the institution, or providing a hyperlink to an electronic survey.

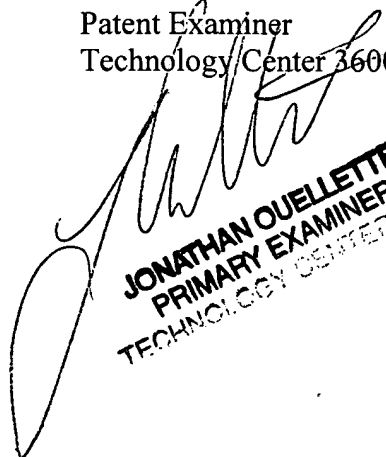
52. However, Schillewaert does disclose the use of “mail surveys” (common technique used in the industry – includes sending postage paid survey form – to hopefully increase respondents) as prior art (pg.1 of 10), and the concepts described by Schillewaert are intended to be an advancement on paper-based survey methods for purposes of increased cost savings, convenience, and flexibility (pg.1 of 10).
53. Schillewaert also discloses sending emails to potential users, inviting them to participate in online surveys (pg.4 of 10); furthermore, Schillewaert discloses wherein the recruitment for potential candidate would include an explanation of the objectives (institution information) of the study along with communicating the URL (equivalent to hyperlink – hyperlinks commonly created automatically through URL address) used for participating (pg.4 of 10).
54. As per Claim 22, the Applicant has made the argument that the cited prior art fails to expressly teach or disclose the step of using a predetermined metric to electronically convert a free form response to an electronic survey to an indication of interest.
55. However, Schillewaert discloses electronically tracking online survey results to online surveys (pg.2), and the creation of an electronic record via user response would be equivalent to an indication of interest.
56. As per Claim 2, the Applicant has made the argument that the cited prior art fails to expressly teach or disclose e-mailing each candidate from a named individual at an e-mail address, which includes the name of the institution.
57. However, Thomas discloses sending the user an email, which includes notification and instruction information (Para 0065), both of which would obviously include information regarding who/what was sending the survey to be completed by the participant.

Conclusion

58. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
59. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
60. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

November 28, 2006

Jonathan Ouellette
Patent Examiner
Technology Center 3600


JONATHAN OUELLETTE
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